

## **REMARKS**

### **I. PRELIMINARY REMARKS**

Claims 14, 18, 22 and 25 have been amended. Claim 21 has been canceled. No claims have been added. Claims 1-16, 18-20, and 22-29 remain in the application. Reexamination and reconsideration of the application, as amended, are respectfully requested.

Applicant notes with appreciation that claims 5, 6, 16, 19, 20 and 26 have been allowed and that the Office Action indicated that claims 8, 9 and 22-24 would be allowable if rewritten in independent form. As claim 22 has been rewritten in independent form, applicant respectfully submits that claims 22-24 are in condition for allowance.

Additionally, as claim 18 has been amended so as to depend from allowed claim 16, applicant respectfully submits that claim 18 is in condition for allowance.

### **II. FORMALISTIC ISSUES**

Claim 18 has been objected to. Applicant respectfully submits that the objection has been obviated by the amendment above, which makes claim 18 dependent on claim 16, and should be withdrawn.

Claim 14 has been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully submits that the rejection under 35 U.S.C. § 112 has been obviated by the amendment above. More specifically, claim 14 has been amended so as to depend from claim 13. The rejection under 35 U.S.C. § 112 should, therefore, be withdrawn.

### III. PRIOR ART REJECTIONS OF CLAIMS 1-4, 7, 10, 21, 25 AND 27-29

#### A. The Rejections

Claims 1, 3, 4, 7, 10 and 27-29 have been rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 6,549,942 to Janky ("the Janky patent"). Claim 2 has been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the Janky patent and U.S. Patent No. 6,263,381 to Freadman ("the Freadman patent"). Claims 21 and 25 have been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the Janky patent and U.S. Patent No. 6,619,597 to Sheppard ("the Sheppard patent").

As claim 21 has been canceled and claim 25 has been amended so as to depend from allowable claim 22, applicant respectfully submits that the rejection of claims 21 and 25 under 35 U.S.C. § 102 has been rendered moot. The rejections of the remaining claims under 35 U.S.C. §§ 102 and 103 are respectfully traversed. Reconsideration thereof is respectfully requested.

#### B. Discussion Concerning Claims 1-4, 7, 10 and 27-29

Independent claim 1 calls for a combination of elements including "**a portable computer** including a keyboard, a display, a housing, a computer electrical connector and a computer mechanical connector" and "a recorded media storage and playback device including a housing defining an exterior, a speaker, a user-manipulatable playback control element associated with the exterior of the housing, a storage and playback device electrical connector configured to mate with the computer electrical connector and a storage and playback device mechanical connector configured to mate with the computer mechanical connector." Claims 2-4, 7, 10 and 27-29 depend from independent claim 1 and include, *inter alia*, the combination defined by claim 1. The cited references fail to teach or suggest such combinations.

The Janky patent discloses a system including a personal computer 51 and a storage and playback unit 81. In contrast to the invention defined by independent

claim 1, the Janky storage and playback unit 81 is connected to the personal computer 51 by way of a docking station 79. [Note Figure 1 and column 6, lines 12-28.] In an attempt to read claim 1 onto the system disclosed in the Janky patent, the Office Action has taken the position that docking station 79 is part of the personal computer 51. [Office Action at page 3.] Applicant respectfully submits the Janky patent does not support this position.

For example, the Janky patent indicates in the “summary of the invention” that audio files are received by a user who has three things – a personal computer, a modem and a docking station. [Column 2, lines 20-27.] There is no indication that docking station is part of the personal computer. Figure 1 also clearly illustrates the docking station 79 as a device that is (1) outside the rectangle which represents the personal computer 51 and (2) connected to the personal computer 51 by way of a communication module 74. The Janky “description of the best modes” also fails to describe the docking station 79 as being part of the personal computer 51. Instead, the “description of the best modes” portion of the Janky patent indicates that the personal computer 51 has a communication module and that the communication module is connected to the docking station 79. [Column 6, lines 12-15.] Accordingly, applicant respectfully submits that the docking station 79 appears to be similar to the docking stations that are commonly used in combination with PDAs, i.e. a separate device that is connected to a communication port (or “module”) on a personal computer.

As the Janky patent fails to teach or suggest each and every element of the combination recited in independent claim 1, applicant respectfully submits that claims 1, 3, 4, 7, 10 and 27-29 are patentable thereover and that the rejection of claims 1, 3, 4, 7, 10 and 27-29 under 35 U.S.C. § 102 should be withdrawn.

Turning to the rejection of claim 2 under 35 U.S.C. § 103, applicant respectfully submits that the Freadman patent fails to remedy the aforementioned deficiencies in the Janky patent with respect to independent claim 1. As such, applicant respectfully submits that claim 2 is patentable for at least the same reasons as claim 1 and that the rejection of claim 2 under 35 U.S.C. § 103 should also be withdrawn.

#### **IV. PRIOR ART REJECTIONS OF CLAIMS 11-15**

##### **A. The Rejections**

Claims 11 and 13-15 have been rejected under 35 U.S.C. § 102 as being anticipated by the U.S. Patent No. 6,540,685 to Rhoads ("the Rhoads patent"). Claim 12 has been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the Rhoads patent and the Freadman patent. The rejections under 35 U.S.C. §§ 102 and 103 are respectfully traversed. Reconsideration thereof is respectfully requested.

##### **B. The Rhoads Patent Is Not Prior Art**

35 U.S.C. § 102(e) requires that the claimed invention be described "in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant." As illustrated by the declaration of Memphis Yin, which is being filed concurrently herewith, the inventions defined by claims 11-15 were conceived prior to the Rhoads application filing date of November 9, 2000, and there was diligence from prior to November 9, 2000 up to the June 22, 2001 filing date of the above-identified application.

Applicant respectfully submits, therefore, that the Rhoads patent is not prior art under 35 U.S.C. § 102(e) with respect to claims 11-15 and that the rejections of claims 11-15 under 35 U.S.C. §§ 102 and 103 should be withdrawn.

##### **C. The Cited References Also Fail To Teach Or Suggest The Claimed Combinations**

Independent claim 11 is directed to a portable computer that comprises "a main housing," "a keyboard and a display associated with the main housing" and "a handle associated with the main housing and including a data connector and a mechanical connector." Claims 12-15 depend from claim 11 and include, *inter alia*,

each of the elements recited in independent claim 11. The cited references fail to teach or suggest such combinations.

For example, the Office Action has apparently taken the position that the Rhoads transducer connector 21 shown in Figure 3 corresponds to the claimed "handle." Applicant respectfully submits that one of skill in the art would understand that the Rhoads connector 21 is not a "handle," as this term is used in the present application. It is also noteworthy that the ultrasound device illustrated in Figure 3 is carried with a shoulder strap (note Figure 2) and that, in the Rhoads embodiment that does include a handle, the handle lacks the claimed data and mechanical connectors (note Figure 10). Accordingly, for reasons in addition to those discussed above, the rejection of claims 11 and 13-15 under 35 U.S.C. § 102 should be withdrawn.

Turning to the rejection of claim 12 under 35 U.S.C. § 103, applicant respectfully submits that the Freadman patent fails to remedy the aforementioned deficiencies in the Rhoads patent. As such, for reasons in addition to those discussed above, the rejection of claim 12 under 35 U.S.C. § 103 should also be withdrawn.

#### **IV. CLOSING REMARKS**

In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are respectfully requested. Allowance of the claims at an early date is courteously solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant's undersigned representative at (310) 563-1458 to discuss the steps necessary for placing the application in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 08-2025. Should

such fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

2/23/04  
Date

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Respectfully submitted,  
  
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